



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,491	07/31/2001	Shoulian Dong	3417	1435

22886 7590 04/22/2004

AFFYMETRIX, INC
ATTN: CHIEF IP COUNSEL, LEGAL DEPT.
3380 CENTRAL EXPRESSWAY
SANTA CLARA, CA 95051

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

Advisory Action**Application No.**

09/920,491

Applicant(s)

DONG, SHOULIAN

Examiner

Frank W Lu

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 19 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 20, 22, 24-27, 29-31, 33, 35-41, 43 and 46.Claim(s) withdrawn from consideration: 28, 32, 34, 42, 44, 45, and 47.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11/02, 7/02, and 11/01.
10. ☐ Other: _____

ADVISORY ACTION

1. The proposed amendments filed on March 19, 2004 have been fully considered but will not be entered because they raise new issues that would require further consideration and/or search.

Response to Arguments

I. Regarding 1449 forms filed on November 27, 2002, October 30, 2002, July 3, 2002 and November 19, 2001, since applicant has resubmitted 1449 forms filed on November 27, 2002, October 30, 2002, July 3, 2002 and November 19, 2001 in response to the final office action mailed on December 19, 2003 and the office has rescanned this instant application, this issue related to IDS has been removed.

II. In page 3, fourth paragraph of applicant's remarks, applicant argues that it is unclear why the examiner suggests the substitution of "presented" for "present" in the phrase "to be present on fragments that were cut on one end by the first restriction enzyme and on the other end by the second restriction enzyme are enriched in the amplification product relative to the fragments that were".

This argument has been fully considered but it is not persuasive toward the withdrawal of the objection because the phrase "to be present on fragments" is an incorrect passive tense and correct passive tense for the phrase is "to be presented on fragments".

III. In page 9, first paragraph of applicant's remarks, applicant argues that "[I]n claims 25 and 29, 'polymorphisms' is used in the context of describing an array of probes to detect a plurality of polymorphisms. The polymorphism of the preamble is the polymorphism to be genotyped but it is only one of the polymorphisms that the array is designed to genotype. To

Art Unit: 1634

clarify this applicants have amended claims 25 and 29 to indicate that the array is designed to genotype “a plurality of polymorphism”.

This argument has been fully considered and is moot since applicant has amended the phrase “the alleles present at polymorphisms” in claims 25 and 29 into “the sequence present at a plurality of polymorphisms”. The new amendments in claims 25 and 29 raise new issues that would require further consideration and/or search.

IV. In page 9, fourth paragraph of applicant’s remarks, applicant argues that the phrase “the alleles present at polymorphisms” in claims 20, 25, and 29 is not vague and indefinite because “[A]pplicant's respectfully disagree with the Examiner's assertion that allele must be broader than a polymorphism. An allele is an alternative form of a locus so it may encompass a single polymorphism and Applicants have used the term allele to encompass an alternative form of a polymorphism.”.

This argument has been fully considered and is moot since applicant has amended “the alleles present at polymorphisms” in claims 20, 25, and 29 into “the sequence present at a plurality of polymorphisms”. The new amendments in claims 20, 25, and 29 raise new issues that would require further consideration and/or search.

V. In page 9, last paragraph bridging to page 10, first paragraph of applicant’s remarks, applicant argues that the phrase “the presence or absence of one or more alleles of one or more polymorphisms” in claim 33 is not vague and indefinite because “[A]pplicants again respectfully disagree with the assertion that an allele must be broader than a polymorphism.”.

This argument has been fully considered and is moot since applicant has amended the phrase “the presence or absence of one or more alleles of one or more polymorphisms” into

Art Unit: 1634

“sequences present at one or more polymorphisms” in claim 33. This new amendment in claim 33 raises new issues that would require further consideration and/or search.

V. In page 10, fourth paragraphs bridging to page 12, first paragraph of applicant's remarks, applicant argues that the amendment on claims 20, 25, 29, and 33 have overcome the rejection under 35 USC 102 (e) (McCasky Feazel *et al.*), 35 USC 103 (a) (McCasky Feazel *et al.*, in view of Guire *et al.*), and 35 USC 103 (a) (McCasky Feazel *et al.*, in view of Makarov *et al.*)

This argument has been fully considered and is moot since applicant has amended claims 20, 25, 29, and 33. For example, applicant has added a phrase “wherein the first adaptor is blocked from ligation to the fragments at the 3' end of one strand of the first adaptor, and the second adaptor is blocked from ligation to the fragments at the 5' end of one strand of the second adaptor and wherein the first adaptor ligates to fragments cut by the first restriction enzyme and the second adaptor ligates to fragments cut by the second restriction enzyme” in ligating step of claims 20, 25, 29, and 33. The new amendments in claims 20, 25, 29, and 33 raise new issues that would require further consideration and/or search.

VI. In page 12, paragraphs of applicant's remarks, applicant argues that “[A]pplicants believe that the Su et al. reference should not preclude patentability of the present application according to 35 U.S.C. 103(c), because at the time the invention claimed in 09/920,491 was made, the subject matter of the Su et al. Patent, U.S. Patent No. 6,632,611, and the invention claimed in 09/920,491 were subject to an obligation of assignment to Affymetrix, Inc. The inventors of Su et al. are Shoulian Dong and Xing Su and the inventor of the invention claimed in 09/920,491 is Shoulian Dong. Xing Su and Shoulian Dong were employees of Affymetrix at the time of both

Art Unit: 1634

inventions and had both executed employment agreements obligating them to assign to Affymetrix all inventions made as a result of their employment by Affymetrix.” .

After carefully considers this argument and assignment of U.S. Patent No. 6.632.611 and this instant application, the examiner agrees with withdraw 35 USC 103 (a) on claims 41, 42, and 46 rejected by combining patents of McCasky Feazel *et al.*, and Su *et al.*.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703)872-9306 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)272-0782.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.



FRANK LU
PATENT EXAMINER

Frank Lu
PSA
April 20, 2004